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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mark E. Pecan

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EXAMINER

LY, NGHI H

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,781

Applicant(s)

PECEN ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/24/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8,10,12-26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8, 10, 12-26 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 6, 8 10, 12-26 and 28-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Regarding claim 23, the newly added limitation in claim 23 recites "transmitting packet data messages using the constructed interim IMSI".

Therefore, the claim 23 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 6, 10, 14, 20 and 28-33 are rejected under 35 U.S.C. 102(a) as being anticipated by Stephenson et al (US 6,119,000).

Regarding claims 1, 10, 28 and 33, Stephenson teaches a mobile user device capable of anonymously accessing a network (fig.1, see “PSTN” and it reads on Applicant’s “network”) in the absence of a removable subscriber identity module (SIM) (see column 22, lines 43-51, see “a handset with no SIM inserted”), the mobile user device comprising: a SIM detector detecting whether the SIM is connected to the mobile device (see column 22, lines 43-51, see “a handset with no SIM inserted”, the teaching of Stephenson inherently teaches Applicant’s “a SIM detector” for detecting), circuitry to communicate an International Mobile Subscriber Identity (IMSI) stored on the SIM to a base station (fig.1, see wireless communication between mobile station 12 and base station 18, the teaching of Stephenson inherently teaches Applicant’s “circuitry”), and an interim identity generator coupled to the circuitry for communicating (fig.1, see wireless communication between mobile station 12 and base station 18. The teaching of Stephenson inherently teaches an interim identity generator coupled

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to the circuitry for communicating), the interim identity generator constructing an interim IMSI in response to the SIM not being detected within the mobile user device (column 22, lines 43-51, see "a handset with no SIM inserted"), wherein the interim IMSI is constructed from information stored in the mobile communication device to simulate an IMSI for recognition by a network as an interim IMSI (see column 12, line 56 to column 13, line 36), wherein the circuitry for communicating transmits the interim IMSI for signaling exchanges requiring an IMSI when the SIM is not inserted within the mobile user device (see column 12, line 56 to column 13, line 36 and column 22, lines 43-51, see "a handset with no SIM inserted").

Regarding claims 6 and 20, Stephenson teaches the interim IMSI generated from an interim mobile country code (see column 8, lines 1-7), an interim mobile network code (see column 8, lines 1-7), and pseudo-random digits associated with a portion of an international mobile equipment identity (IMEI) associated with the mobile user device (see column 21, lines 52-64) and the interim IMSI (also see column 21, lines 52-64).

Regarding claim 14, Stephenson further teaches the mobile user device accesses the network along a circuit-switched path (see fig.1 and see column 5, lines 9-13).

Regarding claim 29, Stephenson teaches the interim IMSI is a constructed identity from a plurality of values in the user device (see column 8, lines 8-16).

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Regarding claim 30, Stephenson teaches 30, the circuitry for communicating generates an interim IMSI using two values stored in the mobile (see column 8, lines 8-16 and column 25, lines 26-34).

Regarding claim 31, Stephenson teaches the circuitry for communicating generates an interim IMSI using two codes stored in the mobile (see column 3, lines 11-19).

Regarding claim 32, Stephenson teaches the circuitry for communicating generating an interim IMSI using the MISI and a code stored in the mobile (see column 3, lines 11-19 and column 25, lines 26-34).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

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35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al (US 6,119,000) in view of Official notice.

Regarding claim 8, Stephenson teaches the interim IMSI is constructed using one or more of local information containing an international mobile equipment identity (IMEI) corresponding to the mobile user device (see column 21, lines 52-64), a combination of identities that reside on the SIM card, and information stored in the mobile device that simulates identities that reside on the SIM card (see column 22, lines 42-51), instead of local information containing a pre-computed SPES, local information containing a pre-computed ciphering key as claimed. However, using local information containing a pre-computed SPES, local information containing a pre-computed ciphering key is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Stephenson as claimed, in order to improve local information containing a pre-computed SPES, local information containing a pre-computed ciphering key.

10. Claims 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al (US 6,119,000).

Regarding claims 12, 15 and 16, Stephenson teaches the second home location register computes and transmits an authentication response triplet to the

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mobile user device upon receipt of the interim IMSI (see column 12, line 56 to column 13, line 36 and column 22, lines 43-51, see "a handset with no SIM inserted"). Stephenson does not specifically disclose a second home location register for signaling exchanges utilizing the interim IMSI, wherein the first user identity module directs the interim IMSI to the second home location register, and wherein the second home location register computes and transmits an authentication response triplet to the mobile user device upon receipt of the interim IMSI would have been obvious because the first network and second network have the same function.

However, to include a second home location register for signaling exchanges utilizing the interim IMSI, wherein the first user identity module directs the interim IMSI to the second home location register, and wherein the second home location register computes and transmits an authentication response triplet to the mobile user device upon receipt of the interim IMSI would have been obvious because the first network and second network have the same function. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Stephenson with the second network in order to expand the system coverage.

11. Claims 13, 17-19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al (US 6,119,000) in view of Haverinen et al (US 2002/0012433A1).

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Regarding claims 13, 17 and 18, Stephenson teaches claims 10.

Stephenson does not specifically disclose the mobile user device accesses the network along a packet-switched data path.

Haverinen teaches the mobile user device accesses the network along a packet-switched data path (see [0271]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Haverinen into the system of Stephenson in order to allow recognising the telecommunications network directly from the NAI (see Haverinen, see [0165]).

Regarding claims 19 and 21, the combination of Stephenson and Haverinen teaches the wireless communication system further comprising the first network is a packet-switched data network (see Haverinen, Abstract) and the second network is a circuit-switched data network (see column 5, lines 9-22).

The combination of Stephenson and Haverinen does not specifically disclose a second radio access network positioned along a third data path extending between the mobile user device and the first network, and along a fourth data path extending between the mobile user device and the second network.

However, to include a second radio access network positioned along a third data path extending between the mobile user device and the first network, and along a fourth data path extending between the mobile user device and the second network would have been obvious because the first network and second network have the same function.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Stephenson and Haverinen with the second network in order to expand the system coverage.

Regarding claim 23, Stephenson teaches a method of anonymous network access by a mobile user device (fig.1, see "PSTN" and it reads on Applicant's "network"), comprising: detecting whether a subscriber identity module (SIM) is present (see column 12, line 56 to column 13, line 36 and column 22, lines 43-51, see "a handset with no SIM inserted"), when the SIM is not present, constructing an interim international mobile subscriber identity (IMSI) (see column 12, line 56 to column 13, line 36 and column 22, lines 43-51, see "a handset with no SIM inserted").

Stephenson does not specifically disclose transmitting packet data messages using the constructed interim IMSI.

Haverinen teaches transmitting packet data messages using the constructed interim IMSI (see [0271]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Haverinen into the system of Stephenson in order to allow recognising the telecommunications network directly from the NAI (see Haverinen, see [0165]).

12. Claims 22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al (US 6,119,000) in view of Haverinen et al (US 2002/0012433A1) and further in view of Official notice.

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Regarding claims 22 and 25, the combination of Stephenson and Haverinen teaches the interim IMSI is constructed using one or more of local information containing an international mobile equipment identity (IMEI) corresponding to the mobile user device (see Stephenson, column 21, lines 52-64), a combination of identities that reside on the SIM card, and information stored in the mobile device that simulates identities that reside on the SIM card (see Stephenson, column 22, lines 42-51), instead of local information containing a pre-computed SPES, local information containing a pre-computed ciphering key as claimed. However, using local information containing a pre-computed SPES, local information containing a pre-computed ciphering key is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Stephenson and Haverinen as claimed, in order to improve local information containing a pre-computed SPES, local information containing a pre-computed ciphering key.

Regarding claim 24, Stephenson further teaches the interim IMSI has a length of 15 digits (see column 7, line 65 to column 8, line 7) and includes mobile country code, a mobile network code, and pseudo-random digits associated with a portion of an international mobile equipment identity (IMEI) associated with the mobile user device (see column 8, lines 1-7).

Regarding claim 26, the combination of Stephenson, Haverinen and Official notice teaches detecting whether a signaling message includes the interim IMSI (Stephenson, see column 22, lines 43-51, see "a handset with no

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SIM inserted”), routing the signaling message to a first home location register in response to the signaling message including the interim IMSI (see column 12, line 56 to column 13, line 36 and column 22, lines 43-51, see “a handset with no SIM inserted”). The combination of Stephenson, Haverinen and Official does not specifically disclose a second home location register in response to the signaling message not including the interim IMSI, and computing and transmitting an authentication response triplet from the first home location register to the mobile user device would have been obvious because the first network and second network have the same function

However, to include to a second home location register in response to the signaling message not including the interim IMSI, and computing and transmitting an authentication response triplet from the first home location register to the mobile user device would have been obvious because the first network and second network have the same function.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Stephenson, Haverinen and Official with the second network in order to expand the system coverage.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly



CHARLES APPIAH
PRIMARY EXAMINER